

**AMENDMENT**

Please amend the above captioned application as follows:

**In the Claims:**

Please add newly submitted claims 9-12 herewith provided as Attachment "A".

**REMARKS**

Originally filed claims 1-6 are presented for reconsideration and further examination in view of the following remarks.

Claims 7 and 8 are pending in the application but have been withdrawn from consideration by the Examiner, and are presented for a first substantive examination on the merits.

In the outstanding Office Action the Examiner rejected claims 1-6 under 35 U.S.C. § 102(a) as being anticipated by Challet, U.S. Patent No. 4,422,124; and withdrew claims 7 and 8 from further consideration, making the lack of unity holding final.

By this Response and Amendment:

the rejection of claims 1-6 under 35 U.S.C. § 102(a) is traversed;

the Lack of Unity holding and withdrawal of claims 7 and 8 from further consideration are traversed; and

newly submitted claims 9-12 are added.

Claims 9-12 have been added to claim features of the present invention that were explicitly or inherently disclosed in the application as originally filed, but which were not explicitly claimed in the originally filed claims.

It is respectfully submitted that the above amendments and/or additions do not introduce any new matter to this application within the meaning of 35 U.S.C. § 132. In particular, support for newly submitted claim 9 can be found in the originally filed specification on page 3, lines 12-16; support for newly submitted claim 10 can be found in claim 7, as originally filed; support for newly submitted claim 11 can be found in the originally filed specification on page 3, line 21 to page 4, line 3; and support for newly submitted claim 12 can be found in the originally filed specification on page 4, lines 4-11. Applicant respectfully submits that all presently pending claims are in condition for allowance.

**Rejection of claims 1-6 under 35 U.S.C. § 102(a)**

The Examiner rejected claims 1-6 as being anticipated by a U.S. patent to Challet (U.S. Patent No. 4,422,124). In making this rejection, the Examiner stated:

Claims 1-6 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Challet.

Note figure 2 of Challet which shows plastic ring #14 member with integral pins #15, #16 and a metal hammer #13.

Further cited of interest are LaForest, Johnsson, Ishii and Meury.

### **Response**

Applicant respectfully, but strongly, traverses the rejection. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The present invention, as originally and presently claimed, is directed to a hammer for a piezoelectric actuator comprising a hammer ring and a hammer body. The hammer body has a base portion and an extending axle member, the axle member extending through a central opening of the hammer ring, and the hammer ring being seated on the base portion of the hammer body.

The Challet patent does not show the originally claimed elements in their claimed configuration. In particular, this patent does not disclose a hammer body which mounts a hammer ring.

All the Challet patent shows is a hammer 12 comprising a percussion mass 13 received by and mounted inside the inner bore of cylindrical body 14, the body 14 having two stubs 15 and 16 extending outwardly therefrom. Using the claim language of Claim 1 of the present application, the patent does not disclose a ring which is seated on the base portion of the hammer body and through which extends an axle member that is part of the hammer body. Using the language of the Challet patent, percussion mass 13 is sunk into the cylindrical body 14. Thus, the Challet patent discloses the exact opposite of the claim, that is it discloses a ring which mounts a hammer body, and not a hammer body which mounts a ring.

Thus, claim 1 and claims 2-6 dependent thereon, cannot be anticipated by the Challet patent at least because this reference does not disclose the claimed configuration of elements.

As stated in the present application, the claimed configuration provides the advantages of being easy to manufacture, and of resulting in a perfectly symmetrical and balanced hammer.

For the foregoing reasons, it is respectfully submitted that claim 1, as originally submitted, and consequently also claims 2-6 which depend on, and further limit claim 1, are patentable over the Challet patent, and that these claims are in condition for allowance. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

**SUMMARY OF LACK OF UNITY HOLDING**

The Examiner asserted that there is a "lack of unity", and has withdrawn claims 7 and 8 from further consideration as follows:

Applicant is correct that the restriction requirement set forth in paper no. 4 (12-11-01) should have been obvious expressed as a "lack of unity" since this application is a 371 of PCT/CN99/00061.

There is lack of unity because there is no special technical feature in both groups. Also, the process does not inherently produce the product. The process is specific to molding both the hammer and the ring and inserting the hammer into the ring. The claimed product is not limited to molded materials. Thus the lack of unity holding is deemed proper and is made final. Consequently claims 7 and 8 are withdrawn from further consideration.

**Response**

The Examiner is initially thanked for acknowledging that the restriction requirement set forth in the Office Action dated 12/11/2001 should have been expressed as a "Lack of Unity" holding since this application is a national phase of a PCT application (PCT/CN99/00061).

However, Applicant respectfully, but strongly traverses the Examiner's Lack of Unity holding and requests that this Lack of Unity holding and the withdrawal of claims 7 and 8 from further consideration, be reconsidered and withdrawn.

Applicant submits that the Examiner has misapplied the

standard for asserting the Lack of Unity in the claimed invention as claimed in the originally filed claims.

Such standard can be found in the MPEP.

MPEP § 1850(C) provides that:

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

→ (A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product; or

(B) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process; or

(C) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process, it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process. See also MPEP 1893.03(d).

Applicant respectfully submits that the instant application possesses unity of invention as required by PCT Rules 13.1 and 13.2 and is in full compliance with the requirements of MPEP § 1850(C)

because the application contains "in addition to an independent claim for a given product (claim 1), an independent claim for a process specially adapted for the manufacture of the said product (claim 7). Moreover, as also provided by MPEP § 1850(C) and 1893.03(d) the process of claims 7-8 shall be considered to be specially adapted for the manufacture of the product of originally filed claims 1-6 and newly submitted claims 9-12, because the claimed process inherently results in the claimed product. As further noted in MPEP § 1850(C) and 1893.03(d), the words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

Thus, although the Examiner has asserted that the claimed piezoelectric hammer of claims 1-6 is not limited to molded materials as provided by claim 7-8, this is irrelevant to the unity of invention analysis as required by PCT rules 13.1 and 13.2. Moreover, because the claimed process of claims 7-8 inherently results in the claimed product of originally filed claims 1-6 and newly submitted claims 9-12, Applicant respectfully submits that unity of invention is present.

Accordingly, reconsideration and withdrawal of the Lack of Unity holding is respectfully requested. Reconsideration and withdrawal of the withdrawal of claims 7 and 8 from further consideration is requested and the Examiner is respectfully requested to conduct a substantive examination of these claims.

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**CONCLUSION**

In view of the foregoing, applicant respectfully requests the Examiner to reconsider and withdraw the Lack of Unity holding; to reconsider and withdraw the rejection of claims 1-6; to conduct a substantive examination of claims 7 and 8; to enter newly submitted claims 9-12 in the application; and to allow all of the claims pending in this application.

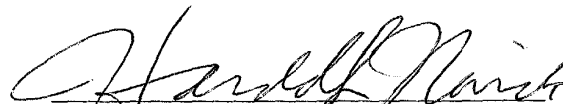
If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

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**Attachment "A"**  
(Newly submitted claims)

9. The hammer of claim 1, wherein said hammer ring member with said two perpendicularly extending integral arms is molded as one single piece.

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10. The hammer of claim 1, wherein said hammer body is molded as one single piece.

11. The hammer of claim 1, wherein the base portion of said hammer body has a shoulder, the hammer ring member has an underside, and said underside is pressed against said shoulder.

12. The hammer of claim 1, wherein said axle member is forcibly fitted inside the central opening of said hammer ring member.